

IN THE MATTER OF AN OPPOSITION by Kenner Parker Toys,
Inc. to application No. 569,858 for the trade-mark PLAYSTUFF filed
by Peter Pan Playthings Limited

On September 25, 1986, the applicant, Peter Pan Playthings Limited, filed an application to register the trade-mark PLAYSTUFF based upon proposed use of the trade-mark in Canada in association with "modelling compound, containers for storing modelling compound, moulds for modelling compound, illustrated mats and miniature toy animal replicas". The applicant was accorded priority filing dates of July 10, 1986 and August 8, 1986 based on its two applications for registration of the trade-mark PLAYSTUFF filed in Great Britain.

The opponent, Kenner Parker Toys, Inc., filed a statement of opposition on April 13, 1988 in which it alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user in Canada by the opponent of the following registered trade-marks with which the applicant's trade-mark is confusing: PLAY-DOH, registration No. 301,288; PLAY-DOH & Design, registration No. 224,650; PLAY-STONE, registration No. 182,304; and PLAY-DOH Design, registration No. 109,695. Accordingly, the opponent further alleged that the applicant's application is not in compliance with Section 29 (now Section 30) of the Trade-marks Act.

The applicant served and filed a counterstatement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of Monica Law and Ruth Stoddart while the applicant filed the affidavit of Alan Booth.

Both the applicant and the opponent filed written arguments and both were represented at an oral hearing.

During the opposition proceeding, the name of the opponent was changed to Tonka Corporation.

Each of the opponent's grounds of opposition is based on allegations of confusion between the applicant's trade-mark PLAYSTUFF and one, or more, of the opponent's registered trade-marks PLAY-DOH, PLAY-DOH Design, PLAY-DOH & Design and PLAY-STONE. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the

Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue. With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, F.C.A. No. A-263-89, dated June 24, 1991, yet unreported).

As the material date in respect of the Section 12(1)(d) grounds of opposition is as of the date of my decision and as the opponent's registered trade-mark PLAY-STONE was expunged from the register as of that date, that registration is of no relevance to the issues in this opposition.

With respect to the inherent distinctiveness of the opponent's trade-mark PLAY-DOH, the applicant submitted that the trade-mark was the name of the opponent's wares and therefore possessed no inherent distinctiveness. However, the applicant failed to adduce any evidence from which I might conclude that the average Canadian would consider that the opponent's trade-mark PLAY-DOH is another name for modelling compound. In my view, the opponent's PLAY-DOH trade-marks possess some measure of inherent distinctiveness when considered in their entirety even though the word DOH, which is the phonetic equivalent of the word "dough", is either descriptive of the character or quality of the opponent's modelling compound, or is arguably that name of the opponent's wares. On the other hand, the applicant's trade-mark PLAYSTUFF possesses a somewhat greater degree of inherent distinctiveness than do the opponent's marks even though the word STUFF suggests that the applicant's modelling compound is made of some unspecified type of material or substance.

No evidence has been adduced by the applicant that its trade-mark has become known to any extent in Canada. With respect to the opponent's trade-mark, the Law affidavit establishes that over 34,800,00 units of PLAY-DOH modelling compound have been sold in Canada over the past twenty years. In my opinion, the opponent's evidence establishes that its trade-mark PLAY-DOH has become well known in this country in association with a modelling compound for children. Likewise, the length of time that the trade-marks at issue have been in use clearly favours the opponent in that the trade-mark PLAY-DOH has been used in Canada since 1969 in association with a modelling compound.

The applicant's modelling compound is identical to the opponent's modelling compound

while the applicant's containers for modelling compound and moulds for modelling compound are closely related to the opponent's wares. Further, from the applicant's statement of wares and the photocopy of the applicant's brochure filed with the Trade-marks Office by the applicant on June 3, 1987, it would also appear that the applicant's illustrated mats and miniature toy animal replicas are wares for use in association with the applicant's modelling compound. To the extent that the wares of the parties are identical or are closely related, I consider that the channels of trade associated with these wares would likewise overlap.

As for the degree of resemblance between the trade-marks at issue, I consider there to be some similarity in appearance and sounding between the applicant's trade-mark PLAYSTUFF and the opponent's PLAY-DOH trade-marks. Further, the trade-marks of the parties suggest that their respective wares comprise some type of material or substance with which children can play.

As a further surrounding circumstance, the applicant relied upon the state of the register evidence furnished by way of the Booth affidavit. This evidence establishes that there has been common adoption of the word PLAY as an element of trade-marks as applied to toys and games. However, apart from the registrations of the opponent and a registration standing in the name of the applicant for the trade-mark PETER PAN PLAYTHINGS & Design (registration No. 278,470), the state of the register evidence establishes that there are only two registrations which include the word PLAY as an element of the trade-mark and covering modelling compounds, these being the registered trade-marks SHAPE & PLAY (registration No. 224,662) and CREATIVE PLAYTHINGS (registration No. 202,280). However, neither of these marks bear any similarity whatsoever to either the applicant's mark or the opponent's trade-marks. In my view, the absence of registered trade-marks including the element PLAY and covering modelling compounds or similar materials is at least as relevant to the issue of confusion as is the existence of a number of registrations including the word PLAY in the general area of toys and games. As a result, I do not consider that a great deal of weight can be accorded to the applicant's state of the register evidence.

As a further surrounding circumstance, the agent for the applicant argued at the oral hearing that the Registrar has no right to refuse the applicant's trade-mark PLAYSTUFF as being confusing with the registered trade-mark PLAY-DOH in that the Trade-marks Office in 1971 accorded a registration for the trade-mark PLAY-STONE covering modelling materials to an entity other than the registered owner of the trade-mark PLAY-DOH despite the existence of the registration for the trade-mark PLAY-DOH. However, a review of the Trade-marks Office file for the trade-mark PLAY-STONE reveals that the original registrant was General Mills Fun Group, Inc., the same entity

as was the then owner of the registered trade-mark PLAY-DOH.

Having regard to the above and, in particular, to the fact that the opponent's PLAY-DOH trade-marks are well known, that the trade-marks PLAYSTUFF and PLAY-DOH are somewhat similar in appearance and sounding and do bear a fair degree of similarity in ideas suggested, and that the modelling compound and related wares of the applicant are either identical or closely related to those of the opponent, I have concluded that the applicant has failed to discharge the legal burden upon it in respect of the issue of confusion.

In view of the above, I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF October, 1991.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.